

REMARKS

In the Restriction Requirement mailed May 14, 2007, the Examiner restricted the claims into the following Groups:

- Group I – claims 2, 3, 6-8, 11-15, 27, 30 and 31 drawn to an antisense oligonucleotide specific for human manganese superoxide dismutase and to a method of treating a tumor, more specifically a breast cancer tumor via administering the antisense oligonucleotide, classified in class 514, subclass 44.
- Group II – claims 2, 3, 6-8, 11-15, 28, 30 and 31 drawn to an antisense oligonucleotide specific for human manganese superoxide dismutase and to a method of treating a tumor, more specifically a glioma tumor via administering the antisense oligonucleotide, classified in class 514, subclass 44.
- Group III – claims 2, 3, 6-8, 11-15, and 29-31 drawn to an antisense oligonucleotide specific for human manganese superoxide dismutase and to a method of treating a tumor, more specifically a melanoma tumor via administering the antisense oligonucleotide, classified in class 514, subclass 44.

The subject matter in the claims of Groups I-III are substantially identical except for the type of tumor to be treated in the claimed methods.

In response to the Restriction Requirement, Applicants provisionally elect, with traverse, the claims of Group I. Applicants traverse the Restriction Requirement on the basis that the Restriction Requirement is improper as a search has been done for methods not limited to a particular cancer to be treated and thus there is no serious burden on the Examiner. Applicants' traversal is supported by M.P.E.P. § 803, which indicates that Restriction Requirements are optional, and that if the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits. *Id.*

The Examiner alleged that the present Restriction Requirement is merited because although the inventions of Groups I-III are directed to related compounds and methods, to search a method for

treating one of the cancer types with an oligonucleotide would not necessarily yield art against a method of treating any of the other cancer types with an oligonucleotide. Thus, the Examiner alleged that to search for more than one of the inventions in the same application presents a search and corresponding examination burden.

Applicants respectfully traverse the Examiner's allegations and submit that the present claims have already been searched. To date, three prior Restriction Requirements have been issued in this application. In the Restriction Requirement mailed June 2, 2004, the Examiner restricted the claims to five Groups, each directed to antisense compounds and methods of targeting a particular antioxidant enzyme. The Examiner subsequently withdrew the Restriction in response to Applicants' argument that the entire application had been searched and examined during previous prosecution and thus there was no burden on the Examiner meriting restriction. See Response to Restriction Requirement, filed on June 30, 2004 in Serial No. 09/993,333, and the Office Action mailed September 23, 2004, page 3. The Office Action mailed September 23, 2004 and a final Office Action mailed June 14, 2005, in which the Examiner cited Gonzalez-Zulueta *et al.* as teaching an antisense oligonucleotide targeted to a rat manganese superoxide dismutase in a § 102 rejection of the claims, are further evidence that the Examiner searched and examined claims directed to antisense compounds and methods of treating tumors using the antisense compounds.

In another Restriction Requirement, mailed December 29, 2005, the Examiner again restricted the claims to five Groups, each directed to antisense compounds and methods of treating tumors by targeting a particular antioxidant enzyme. In response to Applicants' election of the claims of Group I, directed to antisense compounds and methods of treating a tumor involving targeting manganese superoxide dismutase, the Examiner again searched and examined these claims as evidenced by the Office Action mailed August 24, 2006. Therefore, Applicants respectfully submit that the subject matter of the claims of Group I, II and III of the present Restriction Requirement have already been searched.

Moreover, assuming for the sake of argument that a search had not been conducted, a search of the composition claims and the method of claim 8 would necessarily include searches for art relevant to methods of treating other cancers including breast cancer, glioma and melanoma as specified in claims 27-29.

For these reasons, the present Restriction Requirement is improper and reconsideration and withdrawal of the Restriction Requirement is respectfully requested as Applicants should not

RESPONSE TO RESTRICTION REQUIREMENT

Serial Number: 09/993,333

Filing Date: November 14, 2001

Title: REDUCTION OF ANTIOXIDANT ENZYME LEVELS IN TUMOR CELLS USING ANTISENSE OLIGONUCLEOTIDES

Page 8

Dkt: 875.042US1

be required to incur additional costs associated with the filing of multiple divisional applications in order to obtain protection for the claimed subject matter.

CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney at (612) 373-6913 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

LARRY W. OBERLEY ET AL.

By their Representatives,

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(612) 359-3261

Date June 14/07 By W. Thai
Wendy Thai, Ph.D., J.D.
Reg. No. 53,684

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 14 day of June 2007.

CANDIS BUENDING

Name

Signature